The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVE NISHIMOTO

Appeal No. 2005-1289
Application No. 09/541,780

ON BRIEF

Before GROSS, BARRY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 15-19.

We affirm-in-part.

BACKGROUND

The invention relates to the communication of data over a double pumped bus. A double pumped bus is an arrangement whereby data is communicated across a single wire in a time multiplexed fashion. One set of data is communicated during time slots that are interleaved with other time slots associated with another set of data. In appellant's disclosed invention, the flow of bits from a particular data set may be selectively blocked. Representative claim 15 is reproduced below.

15. A system comprising:

double pumped bus circuits serially coupled together to form a chain to communicate data from at least two different sets of data, at least one of the bus circuits being capable of being disabled to prevent bits from at least one of the sets of data from being communicated through said at least one of the bus circuits.

The examiner relies on the following evidence:

Tjandrasuwita	6,049,883	Apr. 11, 2000 (filed Apr. 1, 1998)
Sproch et al. (Sproch)	US 6,247,134 B1	Jun. 12, 2001 (filed Mar. 31, 1999)

Applicant's Admitted Prior Art (AAPA) in the specification.

Claims 15 and 17-19 stand rejected under 35 U.S.C. § 103 as being unpatentable over AAPA and Tjandrasuwita.

Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over AAPA, Tjandrasuwita, and Sproch.

Claims 1-14 and 20-23 have been allowed.

The examiner mailed a supplemental Examiner's Answer ("Answer") on November 23, 2002 that substituted for an earlier paper in response to appellant's brief ("Brief") filed February 24, 2003. Appellant in turn filed (Jan. 27, 2005) a paper styled "Supplemental Reply Brief," which we will reference as appellant's "Reply Brief."

OPINION

Appellant argues the merits of claims 15 and 19. Consistent with the rules in effect at the time of filing the briefs, we select claim 15 as representative of the claims subject to the first ground of rejection in this appeal. See 37 CFR § 1.192(c)(7) (2002); 37 CFR § 41.37(c)(1)(vii) (Sep. 13, 2004).

The examiner sets forth findings in support of the rejection of claim 15 at pages 3 and 4 of the Answer. Appellant argues (Reply Brief at 2) that, to derive the claimed invention, the artisan would have done more than merely disable the clock signal (depicted in instant Figs. 1 and 2) to a particular stage. Appellant refers to instant Figure 9, wherein the clock signal for the entire double pumped stage is not merely disabled to prevent a data flow.

As the rejection points out, however, Tjandrasuwita teaches (col. 3, ll. 8-11) that the clock gating apparatus can be coupled to a corresponding one of data paths, allowing the clock gating circuit to enable or disable the corresponding data path as desired. The reference teaches selective disablement of a circuit. Col. 5, l. 48 - col. 6,

l. 22; Fig. 4. Additionally, however, the reference teaches selective disablement of a sub-circuit within the circuit (col. 6, l. 23-59; Fig. 5); in particular, selective disablement of cursor module 401 -- thus enabling or disabling its associated data path -- within graphics/display controller 307. The sub-circuit teaching is applied in the rejection to selective enablement of DATA1 or DATA2, rather than to an entire double pumped stage.

Appellant's arguments do not sufficiently address the specific findings of the examiner. Appellant thus has not persuaded us of error in any of the findings in support of the conclusion of prima facie obviousness. We sustain the rejection of claims 15 and 17-19 under 35 U.S.C. § 103 as being unpatentable over AAPA and Tjandrasuwita.

In response to the rejection of claim 16, appellant argues (Reply Brief at 2) that Sproch fails to teach or suggest disabling alternate double pumped stages. The rejection (Answer at 6-7) relies principally on Figure 8 and column 12, lines 48 through 51 of Sproch for a teaching of disabling alternate double pumped circuits. We note that Sproch teaches serially coupled pipe stages in a pipeline circuit (col. 7, l. 55 et seq. and col. 12, l. 36 et seq.). In any event, in view of the examiner's commentary at pages 7 and 9 of the Answer, it appears that the examiner has identified particular sequences of bits such that, if the sequences were input to bus 242a and bus 242b in the circuit of Figure 8, alternate registers and thus stages may be disabled.

The rejection alleges, but does not show, that the particular sequences of bits would result in the disabling of alternate registers. Even assuming the truth of the matter asserted, however, the rejection does not show suggestion from the prior art for the combination that is contemplated. The rejection instead indicates that an improper legal standard may have been used; i.e., relating to the principles of anticipation rather than obviousness.

The law of anticipation does not require that a reference "teach" what an applicant's disclosure teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983). With respect to obviousness, however, the mere fact that the prior art could be modified to result in the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. See, e.g., In re Laskowski, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Prior art references in combination do not make an invention obvious unless something in the prior art would suggest the advantage to be derived from combining their teachings. In re Sernaker, 702 F.2d 989, 995-96, 217 USPQ 1, 6-7 (Fed. Cir. 1983).

Thus, while Sproch may be deemed to teach circuitry for reducing power requirements when received data is not important (col. 3, l. 56 - col. 4, l. 3), the

reference does not contain the specific teachings attributed to it by the rejection. We conclude that a prima facie case for obviousness has not been established. We do not sustain the rejection of claim 16 under 35 U.S.C. § 103 as being unpatentable over AAPA, Tjandrasuwita, and Sproch.

CONCLUSION

The rejection of claims 15-19 under 35 U.S.C. § 103 is affirmed with respect to claims 15 and 17-19, but reversed with respect to claim 16. The examiner's decision is thus affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

ANITA PELLMAN GROSS
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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) AND
) INTERFERENCES

Timothy N. Trop
Trop Pruner & Hu PC
8554 Katy Freeway
Suite 100
Houston, TX 77024